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| 22850  | 7590 | 04/05/2011 |
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| ALEXANDRIA, VA 22314                               |      |            |

  

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| EXAMINER      |  |
| RIPLEY, JAY R |  |

  

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| ART UNIT | PAPER NUMBER |
| 3679     |              |

  

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| <b>Office Action Summary</b> | <b>Application No.</b><br>10/580,585 | <b>Applicant(s)</b><br>DUBEDOUT ET AL. |  |
|                              | <b>Examiner</b><br>JAY R. RIPLEY     | <b>Art Unit</b><br>3679                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,15-17 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application      |
| Paper No(s)/Mail Date <u>05/25/2006, 08/09/2006</u> .                                  | 6) <input checked="" type="checkbox"/> Other: <u>Attachments A-I</u> . |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 18-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 05/10/2010.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) filed on 05/25/2006 and 08/09/2006 were considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-13, 15-17, and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

**In claim 1**, lines 26-29, the Applicants have added the limitation of "wherein the annular zone extends, axially, from an innermost end of the female thread on a first of the two opposing ends of the female/female connection sleeve to an innermost end of the female thread on a second of the two opposing ends of the female/female connection sleeve". Nowhere in the original disclosure is there any teaching concerning the axial extent of the "annular zone" and nowhere in the original disclosure is there any teaching that would lead one to infer any particular axial extent of the "annular zone".

The Examiner notes that nowhere in the reply filed 02/28/2011 has the Applicant stated where in the original disclosure there is found a basis for this newly presented limitation concerning the "annular zone"; Applicants have merely presented some annotated drawing to indicate an apparently arbitrarily chosen extent of the "annular zone" in page 11 of the reply filed 02/28/2011 and have provided no basis for the indicated "annular zone" from the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-3, 5-13, 15-17, and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**In regard to claim 1**, it is recited in lines 20-23 "with an annular zone having an initial reduced thickness selected such that the section of the sleeve in the region of this zone is greater than or equal to the smallest of the critical sections of the threaded

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elements of the joints". The noted recitation is unclear and creates great confusion as to the scope of the claimed invention since nowhere in the original disclosure is it made clear as to what constitutes the "the smallest of the critical sections of the threaded elements of the joints". **Is this new matter or is there some basis for this newly presented limitation?** Further, it appears that the Applicants are unable to specifically indicate what constitutes a "critical section" as evidenced by documents filed by the Applicant (see Attachments A and B) and, as such, how can one be expected to be fully apprised as to the scope of the claimed invention in light of the original specification and prosecution of the instant application? Applicant should properly indicate in the response to this Office action precisely where in the original disclosure it is made clear what constitutes "the smallest of the critical sections of the threaded elements of the joints".

**In regard to claim 20**, it is recited in lines 1-2, "The assembly according to claim 3, wherein said dish extends substantially in a zone between last threads of the two female threads". The Examiner notes that "last ends" of threads may be inner or outer threads, the outer threads extending axially further than the inner threads in a female/female threaded connection sleeve structure. It appears that the limitations of claim 20 are broader in scope as concerns the extent of the dish than that which is required in preceding claims. Claim 1, upon which claim 20 depends, requires that the "annular zone extends, axially, from an innermost end of the female thread on a first of the two opposing ends of the female/female connection sleeve to an innermost end of the female thread on a second of the two opposing ends of the female/female

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connection sleeve" (lines 26-29). The Examiner notes that claim 2 requires that the "zone of reduced thickness is in the form of a dish" and the "zone of reduced thickness" is a portion of the "annular zone". Applicant should either satisfactorily explain how the limitations of claim 20 are not broader in scope than required by previous claims or cancel claim 20.

Claims depending upon indefinite claims are indefinite by virtue of their dependence. Where a claim is indefinite, those claims that depend from it will thereby incorporate the indefinite limitations. As such, any claims depending upon the above rejected claim(s) are also rejected as indefinite.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**As best understood, claims 1, 6-11, 15-17, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verger et al. (PCT Application Publication WO 03/060370 and henceforth referred to as "Verger") in view of Matsuki (U.S. Patent 3,870,351).**

The Examiner notes that Verger reference is a publication of application PCT/FR02/04546 and was published in French. However, U.S. Patent Application

Publication 2005/0172472, Verger et al. (also referred to as Verger), which was published in English, is a publication of the U.S. national stage application based on application PCT/FR02/04546. Therefore, although U.S. 2005/0172472 is not applied as prior art, it will be referred to herein, where necessary, only as an English language translation of PCT Application Publication WO 03/060370.

**In regard to claim 1**, Verger discloses an assembly of two fluid tight expandable threaded tubular joints, disposed symmetrically (paragraph 2, "Such a joint can exist between two tubes of considerable length, or between a tube of considerable length and a sleeve," where it is commonly understood that a sleeve typically includes two symmetrically disposed, identical joints, for example, that of Matsuki) and each comprising,

a first tubular element arranged at an end of a tube and comprising a first portion, provided with a male thread (paragraph 100, "a male threaded element 1 placed at the end of a first tube 11," Fig. 16), and a second portion extending said first portion (Fig. 16) and comprising:

- i) a first outer surface (45),
  - ii) a first annular lip (13) having a first axial abutment surface (25) and a first inner surface (Fig. 16) and delimited by said first outer surface over a portion of the axial length thereof, and
  - iii) a second abutment surface (Fig. 18), and
- a second tubular element (paragraph 100, "a second tube 12") comprising:

i) a female thread, matching the first male thread and screwed thereto ((paragraph 100, “a female threaded element 2 placed at the end of a second tube 12,” Fig. 16; also, see paragraphs 70 and 72, “FIG. 14 represents a fourth phase of the screwing of the joint” and “FIG. 16 is a view similar to FIG. 14, relating to a variant,” i.e., although the threads are not explicitly shown in Fig. 16, it appears from the translated description of the drawings that the embodiment of the invention relied on herein includes threads just as does the first disclosed embodiment of Verger),

ii) a second annular lip, having a third abutment surface (Fig. 18), a second outer surface (18), configured to be arranged to face said first inner surface, and a second inner surface (Fig. 16), and wherein

iii) a third inner surface (40) and a fourth axial abutment surface (24) defining with the second outer surface an annular recess (14) matching and receiving the corresponding first lip (Fig. 16 or 18), wherein

each second abutment surface rests against the corresponding third abutment surface and/or in that each first abutment surface rests against the corresponding fourth abutment surface (Fig. 16 and/or 18),

wherein the assembly is configured to develop, after diametral expansion in the plastic deformation region, sealing interference contacts sealing the assembly (Fig. 17 or 19), and the first and second tubular elements will be sealed with respect to a pressure difference between the inside and outside of the first and second tubular elements (paragraph 8, “a high performance sealed tubular joint”).



**Verger does not explicitly disclose** the second tubular element being disposed on each of two opposing ends of a female/female connection sleeve, separated by a central portion initially provided, over an outer surface, with an annular zone having an initial reduced thickness selected such that the section of the sleeve in the region of this zone is greater than or equal to the smallest of the critical sections of the threaded elements of the joints, wherein the annular zone extends, axially, from an innermost end of the female thread on a first of the two opposing ends of the female/female connection sleeve to an innermost end of the female thread on a second of the two opposing ends of the female/female connection sleeve.

Nevertheless, **Matsuki teaches** that it is old and well-known in the art to per se to use second tubular elements to form two opposing ends of a female/female connection sleeve, separated by a central portion initially provided, over an outer surface, with annular zone that extends, axially, from an innermost end of the female thread on a first of the two opposing ends of the female/female connection sleeve to an innermost end of the female thread on a second of the two opposing ends of the female/female connection sleeve, the annular zone having an initial reduced thickness selected such that the section of the sleeve in the region of this zone is greater than or equal to the smallest of the critical sections of the threaded elements of the joints (Fig. 1, where the thickness of the central portion of the sleeve 7 appears to be about equal to the critical section of the threaded part of the joint and a "zone" extends between the innermost thread ends) as a conventional feature for connecting threaded tubes.

Therefore, **it would have been obvious to one of ordinary skill in the art to** provide the second tubular elements of Verger in the conventional form of two opposing ends of a female/female connection sleeve separated by a central portion (which is generally disclosed by Verger in paragraph 2, as discussed above), such as that exemplified by Matsuki, for the purpose of realizing the fully predictable and common result of connecting two tubes each having male threads.

**In regard to claim 6**, the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, further discloses said second tubular element comprises, at a selected location of its third inner surface, an inner annular groove (Verger, 44) arranged substantially in the region of said first outer surface (Verger, Fig. 16).

**In regard to claim 7**, the combined teachings of Verger in view of Matsuki, as applied to claim 6 above, further discloses said groove initially comprises at least two curvilinear portions (Verger, Fig. 16).

**In regard to claim 8**, the combined teachings of Verger in view of Matsuki, as applied to claim 7 above, further discloses said curvilinear portions initially have substantially identical radii of curvature (Verger, paragraph 199, “ring shaped ribbing 44 presenting a concave profile markedly in the form of an arc of a circle with a radius of about 10 mm”).

**In regard to claim 9**, the combined teachings of Verger in view of Matsuki, as applied to claim 8 above, further discloses said radius of curvature is initially between approximately 2 mm and approximately 20 mm (Verger, paragraph 199, “ring shaped

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ribbing 44 presenting a concave profile markedly in the form of an arc of a circle with a radius of about 10 mm”).

**In regard to claim 10**, the combined teachings of Verger in view of Matsuki, as applied to claim 7 above, do not explicitly disclose the two curvilinear portions are separated by a substantially cylindrical central portion extending parallel to a longitudinal axis of the assembly.

Nevertheless, **it would have been obvious to one having ordinary skill in the art at the time the invention was made to** change the shape of the inner annular groove. MPEP 2144.04. The Examiner notes that in the instant application, page 10, lines 2-3, teaching of “groove G1 may comprise only two curvilinear portions” the applicant has disclosed that the limitation claimed is an optional (i.e., clearly non-critical) feature of the invention.

**In regard to claim 11**, the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, further discloses said groove initially has a radial depth (Verger, paragraph 210, “the ribbing 44 can have ... a depth in the order of a few tenths of a mm.”), the maximum value of which is selected such that the material section at the bottom of the groove is greater than the product of the smallest section of a common portion of said tubes, and the efficiency of the joint under tension (Verger, Fig. 17).

**In regard to claim 15**, the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, further discloses said male and female threads selected from a group consisting of conical and cylindrical threads and each formed over at least one tubular element portion (Verger, paragraph 104, “male threaded element 3, conical with

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trapezoidal threads” and paragraph 116, “female threading 4 with trapezoidal threads matching the male threading 3”).

**In regard to claim 16**, the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, further discloses said first outer surface and third inner surface are shaped in such a way that, after expansion, a sealing interference contact is defined between a portion of each of them (Verger, Fig. 17).

**In regard to claim 17**, the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, further discloses said first and second expandable tubular elements are shaped in such a way that, after said expansion, a sealing interference contact is defined between an inner end portion of said first lip and said second outer surface (Verger, Fig. 17).

**In regard to claim 22**, the combined teachings of Verger in view of Matsuki, as applied to claim 6 above, further discloses the assembly is configured to develop, after expansion in the plastic deformation region, sealing interference contact of the first annular lip with a portion of the groove (Verger, Fig. 17).

**In regard to claim 23**, the combined teachings of Verger in view of Matsuki, as applied to claim 22 above, further discloses the first annular lip takes on a shape of the portion of the groove after the expansion in the plastic deformation region (Verger, Fig. 17, and paragraph 201, “During expansion of the joint, the concave shape of the ribbing 44 impresses a corresponding convex shape on the peripheral surface 7 of the lip”).

**Claims 2-5, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verger et al. (PCT Application Publication WO 03/060370 and henceforth referred to as "Verger") in view of Matsuki (U.S. Patent 3,870,351) as applied to claim 1 above, and further in view of Metcalfe (PCT Application Publication WO 98/42947).**

**In regard to claim 2**, the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, provide for the claimed invention except for said zone of reduced thickness be in the form of a dish provided with a central portion having said maximum reduced thickness and lateral walls.

Nevertheless, **Metcalfe teaches** that it is old and well-known in the art per se to use a zone of reduced thickness in the form of a dish provided with a central portion having said maximum reduced thickness and lateral walls (Fig. 2) as a conventional feature for controlling the expansion of an expanded tube connection ("the connector 16 and the tubing lengths 24, 25 will expand in corresponding and predictable [i.e., controlled] manner," Metcalfe, page 10, lines 8-11).

Thus, **it would have been obvious to one of ordinary skill in the art at the time the invention was made to** provide the sleeve of Verger in view of Matsuki with a reduced thickness in the form of a dish provided with a central portion having said maximum reduced thickness and lateral walls, such as that exemplified by Metcalfe '947 for the purpose of realizing a predictable result of "minimizing the occurrence of irregularities in the internal diameter of the expanded tubing string." Metcalfe '947, page 10, lines 8-11.

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However, the combined teachings of **Verger in view of Matsuki and Metcalfe do not explicitly disclose the lateral walls inclined at an angle of less than approximately 30°.**

Nevertheless, it **would have been obvious to one having ordinary skill in the art at the time the invention was made to** provide a transition from the intermediate portion to the end portions at a low angle of inclination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Note that in the instant application, page 4, lines 3-4, applicant has not disclosed any criticality for the claimed limitations. Further note that the recitation in claim 2 of a range with an approximate limit is broad enough to encompass values outside of the apparent bounds of the range, i.e., “an angle of less than approximately 30°” can include angles greater than 30°, and it is not clear how far above 30° the range “less than approximately 30°” can extend.

Moreover, the variation of the angle of inclination of the lateral walls amounts to nothing more than a change of the shape of the sleeve. Changing the shape of the sleeve of Metcalfe would have been obvious to one of ordinary skill in the art. MPEP 2144.04.

**In regard to claim 3**, the combined teachings of Verger in view of Matsuki and Metcalfe, as applied to claim 2 above, do not explicitly disclose said angle is equal to approximately 15°.

Nevertheless, **it would have been obvious to one having ordinary skill in the art at the time the invention was made to** provide a transition from the intermediate portion to the end portions at a low angle of inclination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Please note that in the instant application, page 4, lines 3-4, applicant has not disclosed any criticality for the claimed limitations.

Moreover, the variation of the angle of inclination of the lateral walls amounts to nothing more than a change of the shape of the sleeve. Changing the shape of the sleeve of Metcalfe would have been obvious to one of ordinary skill in the art. MPEP 2144.04.

**In regard to 20**, the combined teachings of Verger in view of Matsuki and Metcalfe, as applied to claim 3 above, further discloses a dish extending substantially in a zone between last threads of the two female threads, (Metcalfe as shown in Figure 2).

Where it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the assembly of Verger with the zone of reduced thickness of Metcalfe, it would further have been obvious for the same reasons to provide the zone in the form and location disclosed by Metcalfe.

**In regard to claim 5**, the combined teachings of Verger in view of Matsuki and Metcalfe, as applied to claim 4 above, further discloses a dish extending substantially between said third abutment surfaces of the two second tubular elements, (Metcalfe as shown in Figure 2).

Where it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the assembly of Verger with the zone of reduced thickness of Metcalfe, it would further have been obvious for the same reasons to provide the zone in the form and location disclosed by Metcalfe.

**In regard to claim 21**, the combined teachings of Verger in view of Matsuki and Metcalfe, as applied to claim 2 above, fully disclose the claimed invention, as discussed above regarding claim 6.

**Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Verger in view of Matsuki, as applied to claim 1 above, and further in view of Klementich (U.S. Patent 5,462,315).**

The combined teachings of Verger in view of Matsuki, as applied to claim 1 above, provide for the claimed invention except they do not disclose threads provided with a carrier flank having a negative angle of between approximately  $-3^{\circ}$  and approximately  $-15^{\circ}$  (claim 12) and a stabbing flank having a positive angle of between approximately  $+10^{\circ}$  and approximately  $+30^{\circ}$  (claim 13).

Nevertheless, **it is old and well known per se in the relevant art to use a carrier flank having a negative angle of between approximately  $-3^{\circ}$  and approximately  $-15^{\circ}$  and a stabbing flank having a positive angle of between approximately  $+10^{\circ}$  and approximately  $+30^{\circ}$ , as taught by Klementich** (see Figs. 6A-6D, illustrating that it is known in the art to select the claimed flank angles from among a finite set of known alternatives).



Thus, **it would have been obvious to one of ordinary skill in the art at the time the invention was made to** provide the threads of the combined teachings of Verger in view of Matsuki with flank angles such as those exemplified by Klementich, as an obvious design choice from among a finite set of known, predictable, alternatives with a reasonable expectation of success.

### ***Response to Arguments***

Applicant's arguments filed 02/28/2011 have been fully considered.

**Concerning the Applicants discussion starting in page 10 of the reply filed 02/28/2011**, the discussion appearing to be drawn to the newly presented limitations in claim 1, lines 26-29, of "wherein the annular zone extends, axially, from an innermost end of the female thread on a first of the two opposing ends of the female/female connection sleeve to an innermost end of the female thread on a second of the two opposing ends of the female/female connection sleeve", the arguments are not persuasive.

At the outset, the Examiner notes that the noted newly presented limitations constitutes new matter, since nowhere in the original disclosure is there any teaching concerning the axial extent of the "annular zone" and nowhere in the original disclosure is there any teaching that would lead one to infer any particular axial extent of the "annular zone". The Examiner notes that nowhere in the reply filed 02/28/2011 has the Applicant stated where in the original disclosure there is found a basis for this newly

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presented limitation concerning the "annular zone"; Applicants have merely presented some annotated drawing to indicate an apparently arbitrarily chosen extent of the "annular zone" in page 11 of the reply filed 02/28/2011 and have provided no basis for the indicated "annular zone" from the original disclosure. Arguments drawn to new matter have little weight and are not persuasive.

Further, the new limitation merely requires that there be some arbitrarily chosen zone between the innermost ends of the female threads of the two opposing ends of a female/female connection sleeve. All female/female threaded connection sleeves have such a zone. Applicants' arguments are not persuasive.

Also, it appears throughout the remarks that the Applicants give some kind of weight to referring to an area as "reduced thickness" and "initial". Applicant has nowhere in the claims indicated what this area has a thickness reduced in relation to and, further, the Examiner notes that the instant claims are product claims and not method claims. As such, any area can be considered to be of a "reduced thickness" and it is of little import what something may have been initially, it is what something is NOW, in the instant, that determines patentability. Applicant needs to further define what this "reduced thickness" area is reduced in relation to and recite what structure the Applicants wish patent protection for at the instant moment, not what something was initially. Applicants' arguments are not persuasive.

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**Concerning the Applicants discussion starting in page 10 of the reply filed 02/28/2011**, the discussion drawn an allegation that the prior art of Matsuki (U.S. Patent 3,870,351) is not pertinent to the present claims, the argument is not persuasive.

The invention of Matsuki is a threaded tube joint and the instant invention is a threaded tube joint and as such Matsuki is analogous art. Applicant also alleges that the prior art of Matsuki is not expandable; however, as is apparent in the drawings of Matsuki, his joint is made of metal and therefore the joint is expandable. Also, it appears that the Applicant is improperly arguing the full body incorporation of the invention of Matsuki, since the only teaching of Matsuki is the common female/female connection. Applicants' arguments are not persuasive.

**Concerning the Applicants discussion starting in page 12, last paragraph, of the reply filed 02/28/2011**, the purpose of the discussion is unclear and therefore the arguments are not persuasive.

Applicant comments that "in the art of expandable joints, the initial assembly is a product and the expanded assembly are not merely linked via a process, they are structurally defined in terms of each other. The initial assembly has geometrical features selected to obtain a predetermined result after expansion." The Examiner can only comment that patentability of the instant invention will only be determined based upon the positively recited structure of the invention at one point in time and that applicant should more clearly claim the initial product.

**Concerning the Applicants discussion starting in page 13 of the reply filed 02/28/2011**, the discussion drawn to the prior art of Metcalfe (PCT Application Publication WO 98/42947), the arguments are not persuasive.

Applicant appears to be arguing the full body incorporation of the prior art of Metcalfe and not merely the teaching of the zone of reduced thickness being in the form of a dish.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, the base reference Verger et al. (PCT Application Publication WO 03/060370) seals fluid tight and, therefore, the limitation is met. The arguments are not persuasive.

### ***Conclusion***

Applicant's amendment (for at least the reasons of newly presented limitations in claim 1 in lines 26-29, of "wherein the annular... sleeve" and in lines 20-23 of "with an annular zone... joints") necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. RIPLEY whose telephone number is (571)272-7535. The examiner can normally be reached on Monday through Friday, 1:30 P.M. - 10:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. R. R./  
Examiner, Art Unit 3679  
25 March 2011

/Michael P. Ferguson/  
Primary Examiner, Art Unit 3679